



UNITED STATES PATENT AND TRADEMARK OFFICE

m-f-

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/764,668

01/26/2004

Huitao Liu

1033-LB1007

8818

60533

7590

10/10/2006

TOLER SCHAFFER, LLP
5000 PLAZA ON THE LAKES
SUITE 265
AUSTIN, TX 78746

EXAMINER

REGO, DOMINIC E

ART UNIT	PAPER NUMBER
----------	--------------

2618

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/764,668	LIU, HUITAO	
	Examiner	Art Unit	
	Dominic E. Rego	2684	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/21/2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Croome et al. (*US Patent Application Publication #20040014423*) in view of different part of embodiment.

Regarding claim 1, Croome teaches a terminal comprising:

at least one smart card having first IMSI information (*Page 1, paragraph 0005: Croome teaches the SIM holds a variety of information including the International Mobile Subscriber Identity (IMSI), which uniquely identifies the subscriber*) or a first MSISDN/IMSI combination, that identifies the at least one smart card as an authorized smart card; and

a security function (*PIN value*) that associates the private content stored in the terminal memory with the first IMSI (*Paragraphs 0005 and 0006: Croome teaches the SIM holds a variety of information including the International Mobile Subscriber Identity (IMSI), which uniquely identifies the subscriber, a subscriber private-key (Ki), a copy of the user PIN code, a user phone book, and other data. Access is not granted to the GSM network unless the mobile phone is properly authenticated using a process that relies upon the SIM, so mobile phone also*

Art Unit: 2684

have IMSI to compare with the IMSI store in the SIM) or first MSISDN/IMSI combination of the at least one authorized smart card to grant access to the private content only to the at least one authorized smart card (Paragraph 0006), except for a terminal having private content stored in a memory.

However, in the same art, different embodiment, Croome teaches the invention is particularly applicable to the protection of devices, or device contents, having high intrinsic value (*private content*) store in a memory of the devices, and which can be readily adapted to electronic locking or disabling (Paragraph 0020).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use the teaching of the invention is particularly applicable to the protection of devices, or device contents, having high intrinsic value (*private content*) store in a memory of the devices, and which can be readily adapted to electronic locking or disabling, as taught by Croome, in the mobile phone in order to prevent accessing the private content of the terminal who doesn't know the exact password.

Regarding claims 2,12, and 20, Croome teaches the terminal, wherein the terminal comprises a mobile telephone (*Paragraph 0006*).

Regarding claims 3 and 13, Croome teaches the terminal, wherein the terminal comprises a communicator (*Paragraph 0005 and this is inherent to have a communicator to all the mobile phone*).

Regarding claims 4 and 14, Croome teaches the terminal, wherein the at

Art Unit: 2684

least one smart card comprises a SIM (*Paragraph 0005*).

Regarding claim 5, Croome teaches the terminal, wherein the terminal further comprises a private content IMSI/MSISDN associated with the private content, wherein the security function (*PIN value*) denies access to the private content to a smart card that is not an authorized smart card (*access denies when incorrectly entering the password which is not matched with SIM password, so it's not an authorized smart card*) and grants access to the private content to an authorized smart card (*Paragraphs 0005 and 0006*).

Regarding claims 6,7,10,11,16 and 18, Croome teaches the terminal, wherein the private content comprises discreet items, and the private content IMSI/MSISDN is associated with each discreet item (*Paragraph 0005: Croome teaches the SIM holds a variety of information including the International Mobile Subscriber Identity (IMSI), which uniquely identifies the subscriber, a subscriber private-key, a copy of the user PIN code, a user phone book same as group of contact information, and other data which can be discreet items such as MP3 file, a jpeg image, or a ring tone*).

Regarding claim 8, Croome teaches the terminal, wherein the terminal comprises a GSM terminal (*Paragraph 0005*).

Regarding claim 9, Croome teaches a method comprising the steps of:
providing the private content with private content IMSI/MSISDN information (*Paragraphs 0005 and 0006: Croome teaches the SIM holds a variety of information including the International Mobile Subscriber Identity (IMSI), which uniquely identifies the subscriber, a subscriber private-key (Ki), a*

Art Unit: 2684

copy of the user PIN code, a user phone book, and other data. Access is not granted to the GSM network unless the mobile phone is properly authenticated using a process that relies upon the SIM, so mobile phone also have International Mobile Subscriber Identity (IMSI) to compare with the IMSI store in the SIM);

associating the private content IMSI/MSISDN information with at least one SIM from a plurality of SIMs (*Paragraph 0005: Croome teaches the SIM holds a variety of information including the International Mobile Subscriber Identity which is one of plurality of SIMs*), each SIM of the plurality of SIMs including respective IMSI/MSISDN information (*Paragraphs 0005 and 0006: Croome teaches the SIM holds a variety of information including the International Mobile Subscriber Identity (IMSI), which uniquely identifies the subscriber, a subscriber private-key (Ki), a copy of the user PIN code, a user phone book, and other data. Access is not granted to the GSM network unless the mobile phone is properly authenticated using a process that relies upon the SIM, so mobile phone also have IMSI to compare with the IMSI store in the SIM);*

comparing the private content IMSI/MSISDN information with the IMSI/MSISDN information of a SIM from the plurality of SIMs (*Paragraphs 0005 and 0006: Croome teaches the SIM holds a variety of information including the International Mobile Subscriber Identity (IMSI), which uniquely identifies the subscriber, a subscriber private-key (Ki), a copy of the user PIN code, a user phone book, and other data. Access is not granted to the GSM network unless the mobile phone is properly authenticated using a process that relies upon the*

Art Unit: 2684

SIM, so mobile phone also have IMSI to compare with the IMSI store in the SIM) to produce a comparison result; *(user must enter their PIN for comparison by the SIM with the stored PIN value)*; denying access to the private content when the comparison result is negative; and granting access to the private content when the comparison result is positive (*Paragraph 0006*), except for a method of controlling access to private content stored in a GSM/SIM mobile terminal.

However, in the same art, different embodiment, Croome teaches the invention is particularly applicable to the protection of devices, or device contents, having high intrinsic value (*private content*) store in a memory of the devices, and which can be readily adapted to electronic locking or disabling (*Paragraph 0020*).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use the teaching of the invention is particularly applicable to the protection of devices, or device contents, having high intrinsic value (*private content*) store in a memory of the devices, and which can be readily adapted to electronic locking or disabling, as taught by Croome, in the mobile phone in order to prevent accessing the private content of the terminal who doesn't know the exact password.

Regarding claim 15, Croome teaches, a system comprising:

mobile equipment that accesses a wireless network by radio transmission and reception using 3GPP protocols (*Paragraph 0001*), wherein the mobile equipment comprises private content stored on the internal memory of the mobile equipment, and further wherein the private content, or a pre-determined portion

Art Unit: 2684

thereof, is associated with IMSI and MSISDN information unique to an owner of the private content or the pre-defined portion of the private content (*Paragraphs 0005 and 0006: Croome teaches the SIM holds a variety of information including the International Mobile Subscriber Identity (IMSI), which uniquely identifies the subscriber, a subscriber private-key (Ki), a copy of the user PIN code, a user phone book, and other data. Access is not granted to the GSM network unless the mobile phone is properly authenticated using a process that relies upon the SIM, so mobile phone also have IMSI to compare with the IMSI store in the SIM*); and

at least one SIM containing subscriber information and service or application profiles (*subscriber private-key, a copy of the user PIN code (private content), a user phone book same as group of contact information, and other data*), wherein the SIM identifies the subscriber by IMSI and MSISDN information stored on the SIM (*Paragraph 0005: Croome teaches the SIM holds a variety of information including the International Mobile Subscriber Identity (IMSI), which identifies the subscriber, a subscriber private-key, a copy of the user PIN code, a user phone book, and other data*);

wherein access to all or to the pre-defined portion of the private content occurs only when the IMSI/MSISDN information of the SIM correlates (*matches*) to the IMSI/MSISDN information of the private content, or of the pre-defined portion of the private content, stored in the memory of the mobile equipment (*Paragraphs 0005 and 0006: Croome teaches the SIM holds a variety of information including the International Mobile Subscriber Identity (IMSI), which*

Art Unit: 2684

uniquely identifies the subscriber, a subscriber private-key (Ki), a copy of the user PIN code, a user phone book, and other data. Access is not granted to the GSM network unless the mobile phone is properly authenticated using a process that relies upon the SIM, so mobile phone also have IMSI to compare with the IMSI store in the SIM), except for a private content stored in the internal memory of a mobile terminal.

However, in the same art, different embodiment, Croome teaches the invention is particularly applicable to the protection of devices, or device contents, having high intrinsic value (*private content*) store in a memory, and which can be readily adapted to electronic locking or disabling (Paragraph 0020).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use the teaching of the invention is particularly applicable to the protection of devices, or device contents, having high intrinsic value (*private content*) store in a memory of the devices, and which can be readily adapted to electronic locking or disabling, as taught by Croome, in the mobile phone in order to prevent accessing the private content of the terminal who doesn't know the exact password.

Regarding claims 17 and 19, Croome teaches the system, wherein the private content comprises one or more of the following items: (a) one or more ring tones, (b) one or more games, (c) one ore more images, (d) one or more video files, or (d) one or more audio files (*Paragraph 0005: Croome teaches the SIM holds a variety of information including the International Mobile Subscriber Identity (IMSI), which uniquely identifies the subscriber, a subscriber private-key,*

Art Unit: 2684

a copy of the user PIN code, a user phone book same as group of contact information, e.g. phone numbers, and other data which can be discreet items such as MP3 file, a jpeg image, or a ring tone).

Response to Arguments

3. Applicant's arguments filed 07/21/2006 have been fully considered but they are not persuasive. Regarding claim 1,9, and 15, applicant argues that Croome fails to disclose or suggest access to private content stored in a terminal memory. The examiner disagrees. Anytime you need a password to enter the system, there is private content or personal information stores inside. In this case, mobile phone will let you access to the network if the password that store inside the mobile phone match with the SIM (Paragraph 0006). Also, in paragraph 0020, Croome states the invention is particularly applicable to the protection of devices, or device contents, having high intrinsic value (private content) which store inside, and which can be readily adapted to electronic locking or disabling. Applicant argues according to Croome, the user may gain access to the GSM network by entering a PIN that matches the PIN of the SIM. The PIN of Croome is never compared with the IMSI or MSISDN/IMSI combination associated with private content stored in the terminal memory. The examiner disagrees because in paragraphs 0005 and 0006, Croome states the SIM holds a variety of information including the International Mobile Subscriber Identity (IMSI), Identity (IMSI), which uniquely identifies the subscriber, a subscriber private-key (Ki), a copy of the user PIN code, a user phone book, and other data. Access is not granted to

Art Unit: 2684

the GSM network unless the mobile phone is properly authenticated using a process that relies upon the SIM. Means mobile phone also has International Mobile Subscriber Identity (IMSI) which compares with the SIM's IMSI and access denies if the mobile phone is properly authenticated using a process the relies upon the SIM. Dependent claims 2-8, 10-14 and 16-20, see claims rejection for more details.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dominic E. Rego whose telephone number is

Art Unit: 2684

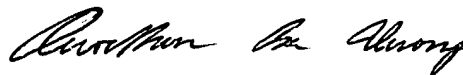
571-272-8132. The examiner can normally be reached on Monday-Friday, 8:30 am-5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on 571-272-7882. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Dominic E. Rego

 9/26/06

QUOCHIEN B. VUONG
PRIMARY EXAMINER